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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,041	04/02/2004	Alakesh Chetia	560142000100	2241

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MORRISON & FOERSTER LLP  
755 PAGE MILL RD  
PALO ALTO, CA 94304-1018

EXAMINER

NGUYEN, HUY D

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/817,041	<b>Applicant(s)</b> CHETIA ET AL.	
	<b>Examiner</b> Huy D. Nguyen	<b>Art Unit</b> 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-47 is/are rejected.
- 7) ☒ Claim(s) 14 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-8, 11-12, 15, 17, 20-25, 27-30, 33-34, 37-44, 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnes, JR. (US 2003/0220835 A1).

Regarding claims 1, 12, 15, 20, 23, 34, 37, 40, 42, Barnes, JR. teaches a method comprising the acts of: providing a portable computing device (e.g., device 101); determining a geographical location of the device (see paragraph [0096]); storing the geographical location; transmitting from a remote location to the device a marketing communication that relates to the determined location (see [0227], [0228]); providing the transmitted marketing communication to a user of the device (see [0239]); determining, by the device, a behavior of the user subsequent to the provision of the marketing communication (see [0238]); and transmitting information concerning the determined behavior from the device (see [0246], [0247]).

Regarding claims 2, 24, Barnes, JR. teaches the method of claim 1, wherein determining the geographical location comprises using one of a global positioning system, a cellular telephone system locator, or a wireless local area network locator (see [0096]).

Regarding claims 3, 25, 41, Barnes, JR. teaches the method of claim 1, wherein the marketing communication includes at least one of an advertisement or an announcement (see [0227], [0228]).

Regarding claims 5, 27, Barnes, JR. teaches the method of claim 1, wherein the marketing communication relates to at least one of a good or a service ([0220], [0248]).

Regarding claims 6, 28, Barnes, JR. teaches the method of claim 1, wherein transmitting the geographical location uses one of a cellular telephone system, a wide area network, or a wireless local area network ([0096]).

Regarding claims 7, 21, 29, 38, 46, Barnes, JR. teaches the method of claim 1, wherein the determined behavior includes at least one of a speed or direction of travel of the user ([0349]).

Regarding claims 8, 30, Barnes, JR. teaches the method of claim 1, wherein initially the user is provided only a part of the marketing communication and the determined behavior includes a response by the user as to whether the user wants to be provided with a remainder of the marketing communication ([0238]).

Regarding claims 11, 33, Barnes, JR. teaches the method of claim 1, wherein the determined behavior includes whether additional information is requested by the user (see [0238]).

Regarding claims 43-44, Barnes, JR. teaches the method of claim 40 except that storing the information is performed at the device ([0139]).

Regarding claims 22, 39, 47, Barnes, JR. teaches the method of claim 1, further comprising the act of displaying one of the marketing communications on a television receiver associated with the portable computing device ([0134]).

Regarding claim 17, Barnes, JR. teaches the method of claim 1, further comprising the acts of: providing at least a portion of the transmitted information to a provider of the marketing communication; and obtaining payment in exchange for the provision of the transmitted information ([0014]).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, JR. (US 2003/0220835 A1).

Regarding claims 4, 26, Barnes, JR. teaches the method of claim 1 except that the announcement is non-commercial. However, it would have been an obvious matter of design choice to have the announcement being non-commercial since it appears that the invention would perform equally well with the announcement being non-commercial.

5. Claims 9-10, 16, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, JR. (US 2003/0220835 A1) in view of Bentolila et al. (US 2003/0101451 A1).

Regarding claims 9-10, 16, 31-32, Barnes, JR. teaches the method of claim 1 except that the determined behavior includes a length of time the user watches or listens to the marketing communication. However, the preceding limitation is taught in Bentolila et al. (see [0105]). It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the teaching of Bentolila et al. to the teaching of Barnes, JR. for accurate users behavioral prediction and modeling.

6. Claims 13, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, JR. (US 2003/0220835 A1) in view of Ross (EP 1379098 A1).

Regarding claims 13, 35, Barnes, JR. teaches the method of claim 12 except that the determined behavior includes a length of time the user was at the specified location. However, the preceding limitation is taught in Ross (see the Abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the teaching of Bentolila et al. to the teaching of Ross for accurate users behavioral prediction and modeling.

7. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, JR. (US 2003/0220835 A1) in view of Dupray (US 2004/0198386 A1).

Regarding claims 18-19, Barnes, JR. teaches the method of claim 1 except that the marketing communication is originated by a provider, and further comprising the act of communicating the marketing communication from the provider to a central server. The preceding limitation is taught in Dupray (see [0154], [0169]). It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the teaching of Dupray to the

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teaching of Barnes, JR. to provide a user with a mobile station interface that allows the user to have a plurality of such intelligent location sensitive agents/applications active simultaneously wherein the user is wirelessly notified when any one or more of these agents/applications detect a condition or circumstance that may be of interest to the user.

8. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes, JR. (US 2003/0220835 A1) in view of Raith (U.S. 6,711,408).

Regarding claim 45, Barnes, JR. teaches the method of claim 43 except the acts of: transmitting the stored information to a remote location; aggregating the stored information with information pertaining to other users; and reporting the aggregated information. The preceding limitation is taught in Raith (see column 13, lines 39-51). It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the teaching of Raith to the teaching of Barnes, JR. for statistical data.

***Allowable Subject Matter***

9. Claims 14, 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 14 and 36, the prior arts, either alone or in combination, fail to teach the method of claim 12, wherein the determined behavior includes a number of times the user was at the specified location over a predetermined time period.

***Contact Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy D. Nguyen whose telephone number is 571-272-7845. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huy Nguyen



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER